DETAILED ACTION

1. Claims 1-6 are currently pending.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-5 in the reply filed on March 6, 2008 and phellodendron for the species in the interview of April 3, 2008 is acknowledged. The traversal is on the ground(s) that the two groups of invention do not lack unity because the claims must be interpreted in light of the specification. This is not found persuasive because Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, claiming the composition to be a "deodorant" is considered to be a recitation of intended use. The claims are drawn to a composition comprising phellodendron bark. This composition is known in the art to be used for a purpose other than inhibiting body odor. Thus, the composition itself is not considered to contain a special technical feature that defines the composition over the prior art.

The requirement is still deemed proper and is therefore made FINAL.

3. Claim 6 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 6, 2008.

4. Claims 1-5 are examined on the merits solely in regards to the elected species of phellodendron.

Specification

5. The abstract of the disclosure is objected to because it contains more than one paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claim 5 is directed to a "use" type claim which is a non-statutory category of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 provides for the use of phellodendron bark, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 5 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 5 is also indefinite because it is unclear if this claim is drawn to a method or to a composition. For the sake of examination, the claim is examined as a composition claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Han (US 5,244,662).

Han teaches a composition comprising a phellodendron bark extract (see claims). The reference does not specifically teach that the composition has the same effects on the body as those claimed by applicant; however, since the composition taught by the reference is the same as the claimed composition, the reference composition would inherently have to have the same effects if applicant's invention functions as claimed.

9. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Haga (US 5,344,648).

Haga teaches a composition comprising ground phellodendron bark (see column 2, lines 31-34). The reference does not specifically teach that the composition has the same effects on the body as those claimed by applicant; however, since the composition taught by the reference is the same as the claimed composition, the reference composition would inherently have to have the same effects if applicant's invention functions as claimed.

10. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by CN 1206740.

This reference teaches a composition comprising phellodendron bark used to inhibit body odor.

11. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by CN 1253770.

This reference teaches a composition comprising phellodendron bark extract used to inhibit body odor.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4-11, 13, 15, 17-19, 21 and 22 of copending Application No. 10/949,252 in view of CN 1206740 or CN 1253770.

Appl. '252 claims a deodorant composition comprising an extract from phellodendron. The claims do not state that the extract is obtained from the bark. Both CN '740 and CN '770 teach that the bark of phellodendron is useful in deodorant compositions. Thus, an artisan of ordinary skill would reasonably expect that the bark of the plant could be used to make the deodorant extract in Appl. '252. This reasonable expectation of success would motivate the artisan to modify Appl. '252 to include the use of the bark as the source of the phellodendron extract.

This is a provisional obviousness-type double patenting rejection.

13. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe Hoffman whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday-Thursday, 9:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Coe Hoffman/
Primary Examiner, Art Unit 1655